

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Shell S. Simpson

Group Art Unit: 2625

Serial No.: 10/052,617

Examiner: Thomas, Ashish

Filed: October 25, 2001

Docket No. 10007679-1

For: **System and Method For Print-To-Mail Notification**

RESPONSE TO OFFICIAL COMMUNICATION

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The Official Communication mailed June 24, 2008 has been carefully considered.

In response thereto, please consider the following remarks.

AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 08-2025.

REMARKS

In the Office Communication of June 24, 2008, the Examiner argued that the Examiner's second Examiner's Answer issued on February 5, 2008 was not a supplemental Examiner's Answer but a "substitute" Examiner's Answer. In view of that, alleges the Examiner, the first Examiner's Answer is now vacated and the second Examiner's Answer, which contains new grounds of rejection, controls.

As Applicant noted in Applicant's second Reply Brief filed April 4, 2008, the second Examiner's Answer clearly is a supplemental Examiner's Answer and, as such, is improper because it presents new grounds of rejection. See 37 CFR 41.43(a)(2). Applicant reiterates that 37 CFR 41.43(a)(1) explicitly states that the Examiner "***must acknowledge receipt and entry of the reply brief***" submitted by the Applicant (emphasis added). Because the second Examiner's Answer was filed after Applicant's first Reply Brief, and because the Examiner must acknowledge that filing and the entry of that Reply Brief into the record, the second Examiner's Answer was responsive to the first Reply Brief and therefore comprises a supplemental Reply Brief. Accordingly, the Examiner cannot now operate under the fiction that Applicant never filed the first Reply Brief and submit a replacement for the first Examiner's Answer.

It appears clear that, upon reviewing Applicant's first Reply Brief, the Examiner appreciated the weakness of the rejections upon which Applicant's claims were finally rejected. Instead of reopening prosecution to present new rejections and provide Applicant with a full opportunity to respond to those rejections, the Examiner is now attempting to pass off the second Examiner's Answer as a replacement for the first Examiner's Answer and act as though the issuance of the first Examiner's Answer and

filings of the first Reply Brief never occurred. Applicant submits that this action by the Examiner clearly violates 37 CFR 41.43(a)(1) and 37 CFR 41.43(a)(2) and further is clearly improper given that it unfairly prejudices Applicant. As provided in MPEP 706.07, “[t]he Examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, ***before*** appeal” (emphasis added).

In view of the above, Applicant respectfully requests that the Board either disregard the second Examiner's Answer or remand the application to the Examiner so that the Examiner can present his new rejections in a further non-final Office Action.

CONCLUSION

In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,



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